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In the Supreme Court of the United States

OCTOBER TERM, 1965.

No. 772

JOHN PHIL FELBURN,

Petitioner,

vs.

THE NEW YORK CENTRAL RAILROAD COMPANY, and FRUEHAUF TRAILER COMPANY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit.

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THE NEW YORK CENTRAL RAILROAD COMPANY, and FRUEHAUF TRAILER COMPANY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI To the United States Court of Appeals For the Sixth Circuit.

Petitioner prays that a writ of certiorari issue to review that portion of the Judgment of the United States Court of Appeals for the Sixth Circuit entered August 31, 1965, holding claims 1, 3, 4, 11, 12, 14 and 15 of Patent No. 3,002,636 invalid.

CITATIONS TO OPINIONS BELOW.

The opinion in the United States District Court for the Northern District of Ohio has been reported in 225 F. Supp. 991, and in 140 U. S. P. Q. 126 and is printed at 415a of Appellant's Appendix in the Court of Appeals. The judgment of the District Court is printed at page 415a of the Appendix in the Court of Appeals.

The opinion in the United States Court of Appeals for the Sixth Circuit has been reported in 146 U. S. P. Q. 622, and printed at page 13 of the Appendix herein. The

Judgment of the Court of Appeals is printed at page 12 of the Appendix herein.

JURISDICTION.

Jurisdiction of the Court is invoked under 28 U. S. C. Section 1254(1). (Appeal from a United States District Court.) The Statute Section is printed at page 10 of the Appendix herein. The Judgment was entered August 31, 1965.

QUESTIONS PRESENTED FOR REVIEW.

Is the intent of Congress in establishing the test of invention nullified where the acts of a subsequent inventor are relied upon in order to determine what would be obvious to one of ordinary skill in the art?

STATUTES RELIED UPON.

Title 35 U. S. C. Sec. 102. (The Patent Act) Printed in the Appendix herein at page 10.

Title 35 U. S. C. Sec. 103. (The Patent Act) Printed in the Appendix herein at page 12.

STATEMENT OF THE CASE.

This request for certiorari concerns a patent, No. 2,002,636,[1] on a Road-to-Rail transportation method. In the system of claim 1 of the patent the enormous and cumbersome van of a semi-trailer, in an effective series of steps, is separated from its wheels, cantilevered part way onto a rail car, and swung by a vehicle into position on the rail car. This system was charged to be infringed by the Mark III system of Defendant-Respondent New York Central Railway. Advertisements and admissions of Defendant indicated that traveling without its wheels such a structure rides securely and with a low center of gravity thereby enabling the train to achieve passenger train speeds on passenger train tracks.[2] Moreover, there was no longer any need for a special platform or ramp or an overhead crane.[3] For the first time cars could be loaded or unloaded at any railroad siding approachable by a road.[4] Vans could be spot loaded anywhere along the train without waiting.[5] In claim 11, the van was center loaded and swung by hand. This system was charged to be infringed by Defendant-Respondent New York Central Railway's Flexi-Van System. No showing was made that any of the prior art systems relied upon the Appellate Court were known to be used commercially. The only other presently used system, known as the "Circus Train" type of piggy back transportation, loads a van, with its wheels still attached by rolling the van down a series of rail cars. A graphic comparison dramatically illustrates the differences between the Circus Train systems, and the system used by Defendant-Respondent New York Central Railway which

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[1] Appellant's Appendix in the Court of Appeals, page 265a.
[2] *Ibid.* at 305a, 308a and 316a-317a.
[3] *Ibid.* at 308a and 312a.
[4] *Ibid.* at 308a.
[5] *Ibid.* at 308a.

is charged to infringe the '636 patent. The comparisons, which consist of advertisements made by Defendant-Respondents is contained in pages 305a and 406a of Appellant's Appendix on Appeal. The District Court for the Northern District of Ohio having jurisdiction based on 28 U. S. C. Sec. 1338(a) held that the steps of the claims of Patent No. 2,002,636 were not novel, and obvious and thus the patent was invalid and non-infringed. The Court also held another patent, Patent No. 2,693,889 invalid and non-infringed. Patent No. 2,693,889 is not part of the present request for certiorari. The Court of Appeals for the Sixth Circuit held that the District Court erred in holding the claims not in suit invalid, and in holding that the discovery of the '636 patent was not novel, and reversed the District Court on these points. The Appeals Court held claims 1 and 11 of the '636 patent invalid. The Appeals Court did so on the basis of "speculation," and on the alleged fact that another person's discovery of the same subject matter, subsequent to Plaintiff-Petitioner's discovery thereof, showed that the discovery was obvious. The Appeals Court stated:

> "The Behrens testimony and disclosure, while not a technical 'anticipation' of the '636 patent under section 102, is, we think, pertinent evidence bearing upon what a person of ordinary skill in the art could be expected to evolve * * * we think it would be gross error to rely solely upon our own speculation as to what the art taught one of ordinary skill at the time Felburn made the invention of the '636 patent, when we have the advantage of considering what Behrens did."

But Behrens was an inventor.[6]

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[6] He has a German Patent on his concept. (Defendant's Physical Exhibit J, Book of Patents, a translation thereof is in Defendant's Physical Exhibit J-1). The brochure testifies to the outstanding nature of his solution. (Defendant's Physical Exhibit K-1).

REASONS FOR GRANTING THE WRIT.

Review is requested in order that the bench and bar may be guided in determining who is the man of ordinary skill in the art to whom the question of "obviousness" of Section 103 of the Patent Act is directed. In treating the question of obviousness in recent cases,[7] the Supreme Court has dealt with the tests of what is obvious to the man of ordinary skill, but not with how the bench and bar shall know *who* is the man of ordinary skill. In such cases, only half of the "obviousness" question has been considered. Certiorari is requested in order that the definition of what is invention, which has recently been undertaken by this Court, may be completed. If the other half of the question, the portion relating to who is the man of ordinary skill, is not considered, the intent of Congress in establishing the Standard of Invention is made a nullity.

The question of who is the man of ordinary skill is very well placed in focus by this case. The Appellate Court in its opinion indicates that its opinion was based either "solely" on its own "speculation," or on "what Behrens did." [8] But Behrens, the person "having ordinary skill in the art" to whom the Appellate Court looked, was himself an inventor. He held a later issued German patent[9] on the developement which allegedly showed what one of "ordinary" skill would do. Behrens, the man to whom the Court looked to as the person of "ordinary skill," in his patent and brochure developed a system which allegedly swept away the difficulties of the prior

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[7] *Graham vs. John Deere*, No. 11, Oct. Term, 1965; *Calmar, Inc. vs. Cook Chemical Co.*, No. 37, Oct. Term, 1965; *Colgate-Palmolive Co. vs. Cook Chemical Co.*, No. 43, Oct. Term, 1965; and *Adams vs. United States*, No. 55, Oct. Term, 1965.

[8] Appendix herein at page 27.

[9] Defendant's Physical Exhibit J, Book of Patents, and translation thereof, Defendant's Physical Exhibit J-1.

art. Behrens' development allegedly was such an advance that:

> "With the introduction of this system, the struggle between road and rail will come to an end by itself." (Physical Exhibit K-1, Book of Patents—page 11).
>
> "It could reshape completely our system of transportation and gain an importance also outside Europe." (Physical Exhibit K-1—page 15).
>
> "The railroad can save thousands of cars because the unloading or transfer time would be only a fraction of the previous required time." (Physical Exhibit K-1—page 13).
>
> "Special devices at the loading stations are not necessary. Any switchyard work is eliminated if it is disregarded that it is necessary to shift one or another railroad car somewhat. Since it is possible to load and unload a train practically at any desired spot, head ramps are practically no longer needed." (Physical Exhibit J-1—page 8).
>
> "With the further development of the system, the railroad can limit the number of its shunting terminals which are very expensive to maintain since the TVB system is developed taking the future shunting requirements in consideration." (Physical Exhibit K-1—page 14).

Thus Behrens was a man who provided solutions which allegedly swept away the difficulties of the prior art, in the field. If, as the Appellate Court held, the subject matter of Behrens is the same as Claim 11 of the patent, he is a giant in the field. The public interest would be greatly adversely affected and the stimulant to invention greatly hampered if a man is to lose a patent because shortly after he discovers a revolutionary method, the same concept is discovered by an Edison or an Einstein. The standard is changed from a worker of "ordinary" skill to one of "extraordinary skill" in the art. The test

is then—is this obvious to an Edison? The intent of Congress would be destroyed. The attempts to define what is invention are set far back, and become a nullity because they are being applied to the wrong person.

Another reason for granting certiorari is for this Court to exercise its supervisory power in regions of public interest. This invention occurred in the railroad industry—an industry unquestionably needing improvements that it may be able to efficiently compete with its chief competitor—the trucking industry. The public has an interest where a device is so revolutionary that only two systems are known to operate today—the system loading from an end of a rail car and leaving the wheels on (the Circus Train) and the loading from the side, separating the wheels and swinging by a vehicle, the system of Plaintiff allegedly used by Defendants, that the invention be considered in the light of a proper standard. Unlike the Circus Train method this invention provided a system permitting freight trains to travel at passenger train speeds on the passenger train lines, clearing the low underpasses thereon.[10] It completely streamlined the road-to-rail concept. It eliminated the need for ramps and overhead cranes and other permanent structures.[11] It overcame the binding that occurs when center loading takes place and prevented the blocking of adjacent tracks.[12] Indeed Defendant, in our submission, paid tribute to the invention by characterizing their system in its advertising as "revolutionary."[12a] Yet by looking to Behrens as the sole "test," it is deemed "obvious" to have to extract and re-

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[10] Appellant's Appendix in the Court of Appeals, at 305a, 308a and 316a-317a.

[11] *Ibid.*, at 308a, 312a.

[12] *Ibid.*, testimony of Defendant's witness Hinden at 162a-163a.

[12a] Appellant's Appendix in the Court of Appeals, at 254a.

combine five (5) steps from seven different and complete systems to anticipate claim 1.[13] The Court of Appeals admitted that Plaintiff's device was novel.[14] The need was certainly long present. One need only look at the dates of the references—all separate systems, all of which failed to solve the problem.[15] Yet, such seven failures are said to show that the solution, which allegedly recombined them, was "obvious." For example Winn was in 1923, Francis and Ross were in 1934, and Zubatsky was in 1945. McGregor which was before the Patent Office was so remote from claim 1 that it had to be modified by four other references. Nelson in 1957 was still teaching the need for a ramp and leaving the wheels on. Certainly many men were trying to solve the problem and failed. Yet, because another person, himself an inventor, allegedly discovered the same idea after the patentee, the objective tests of inventions are disregarded and the pioneer invention is held to be "obvious." This is the ultimate result of the lack of a proper standard for determining who is the man of "ordinary" skill. Where merely the standard of "obviousness" is defined without defining *who* is the man of ordinary skill, the window to continued confusion is closed, but the door is left open.

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[13] Claim 1 was so advanced that it had two more steps than those held to be disclosed by Behrens. The Appellate Court held that two additional references were needed to be combined to meet the claim. Appendix herein at page 26. Behrens was not held to disclose the swiveling and vehicle swinging steps, but was limited to central swinging. Appendix herein at page 30.

[14] Appendix herein at page 21.

[15] There was no showing that any of the references relied upon by the Court were known to have been used in commercial practice.

CONCLUSION.

For the foregoing reasons, it is requested that this petition for a writ of certiorari be granted.

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APPENDIX.

STATUTES.

28 U. S. C. Sec. 1254. Court of Appeals; Certiorari; Appeal; Certified Questions.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods.

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree.

Act of June 25, 1948, c. 646, 62 Stat. 961; May 24, 1949, c. 139. Sections 106, 63 Stat. 104. (28 U. S. C. Sec. 2101.)

35 U. S. C. Sec. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more

than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Notes—Section 4(b) of the Act of July 19, 1952 provides:

"Section 102(d) of Title 35, as enacted by Section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, Title 35, Sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications."

Section 4(d) of the Act of July 19, 1952 provides:

"The period of one year specified in Section 102(b) of Title 35 as enacted by Section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year."

35 U. S. C. Sec. 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

Before O'Sullivan and McAllister, the Circuit Judges, and Arthur M. Smith, Associate Judge.

APPEAL from the United States District Court for the Northern District of Ohio.

This case came on to be heard on the record from the United States District Court for the Northern District of Ohio and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby modified in accordance with the Opinion, and as so modified the judgment is affirmed.

It is further ordered that the defendants-appellees recover from the plaintiff-appellant the cost on appeal, as itemized below, and that execution therefor issue out of said District Court. Entered by Order of the Court.

CARL W. REUSS,
Clerk of the Court.

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

(Decided August 31, 1965.)

Before O'SULLIVAN and MCALLISTER, Circuit Judges, and ARTHUR M. SMITH, Associate Judge.*

SMITH, Associate Judge. This is an appeal from a judgment of the District Court for the Northern District of Ohio, Eastern Division (Connell, C.J., presiding), dismissing plaintiff Felburn's complaint. 225 F. Supp. 991.

Felburn's complaint alleged infringement of two United States patents, Nos. 2,693,889[1] and 3,002,636[2] (hereinafter '889 and '636, respectively) which were issued to and are owned by Felburn. Defendants denied the allegations of infringement and also raised the affirmative defense of invalidity of both patents. 35 U. S. C. 282. After conclusion of the trial, the District Court adopted, essentially in toto, the findings of fact and conclusions of law proposed by defendants and held 1) that defendants had infringed none of the claims of either patent, and 2) that both patents were invalid.

Before reviewing the questions of validity raised on this appeal, we shall summarize briefly the subject matter of the patents in issue.

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* United States Court of Customs and Patent Appeals, sitting by designation.

[1] Entitled "Trailer with Detachable Load Platform" and issued Nov. 9, 1954 on application serial No. 199,219, filed Dec. 5, 1950, to plaintiff Felburn prior to his change of name from Fellabaum to Felburn. See District Court's Finding of Fact No. 3.

[2] Entitled "Method of 'Piggie-Back' Transportation" and issued Oct. 3, 1961 on application serial No. 16,720, filed Mar. 22, 1960 as a continuation of application serial No. 733,127, filed May 5, 1958, which in turn was a continuation of application serial No. 600,528, filed July 27, 1956.

The '889 Patent.

The '889 patent discloses and claims a semi-trailer and tractor assembly in which the load-carrying platform or base of the trailer can be detached from its wheel assembly or bogie, thereby freeing the bogie and tractor for other uses while the trailer is awaiting loading, unloading or repairs. As pointed out in the specification;

> Heretofore, it has been customary, in the distribution of freight by motor truck, to drive a tractor-trailer unit to the shipping source and either wait for the trailer to be loaded or spot the trailer and return with the tractor unit at a later time when the trailer is loaded. It will be appreciated that this is costly procedure since expensive equipment and personnel is tied up during the time the trailer is loaded or during the time involved in returning for the loaded trailer. * * *
>
> * * * * *
>
> My invention provides means for distributing freight in efficient and economical manner. The freight distributing means of my invention is extremely flexible and may be used in truck-to-truck systems as well as in truck-to-rail systems and comprises components the majority of which are of standard construction or of slightly modified standard construction.
>
> * * * * *
>
> It will be appreciated that because of the interchangeability of equipment, a great savings in initial equipment cost is effected, since my invention requires less equipment than prior systems. Further, because the wheel units are interchangeable and readily removed, any unit requiring mechanical attention may be removed to the repair shop and replaced by a unit in good operating condition.

The system operates as follows: The rear end of the trailer is provided with a cam surface which is engageable with a bumper block located at the edge of a platform, such as a loading dock or railroad flat car. The platform is of a vertical height slightly above that of the trailer base, so that the tractor may back the trailer against the bumper block to cam the rear portion of the trailer up onto the bumper block and remove its weight from the bogie. The underside of the trailer base is provided with tracks extending the full length of the body to permit longitudinal sliding movements of the bogie. A hitch means connects the front end of the bogie to the rear end of the tractor so that after the rear end of the trailer has been backed onto the bumper block, the tractor may be driven away, pulling the bogie along the tracks at the underside of the trailer and out from under the front end of the trailer. Removable jacks are provided to support the front end of the trailer after removal of the tractor and bogie, the jacks being spaced at the outer sides of the trailer to permit the bogie to be withdrawn between them.

Although Felburn's complaint alleged infringement broadly, the District Court noted that, of the four claims of patent '889, only claim 3 is here in suit. We have broken down claim 3 and added reference letters and numerals for ease of analysis:

3. A semi-trailer and tractor unit assembly comprising
   A. a trailer base
      1. adapted to have its forward end supported by a tractor unit removably connected thereto,
   B. a wheel unit
      1. adapted to support the rear portion of said trailer base whereby said base is conjointly

supported by said wheel and tractor units for movement along a roadway,

2. said wheel unit having detachable connection with said trailer base for assembly therewith and disassembly therefrom,

C. the rear portion of said base

1. overhanging said wheel unit
2. and terminating in a depending cam surface
   a. engageable with a load carrying platform of a vertical height slightly higher than the vertical height of said rear portion,
3. whereby the tractor unit may back said semi-trailer against said platform
   a. with sufficient force to cam said rear portion upwardly to overlie said platform
   b. so that the load of the rear end of said base is removed from said wheel unit to provide for ready disassembly of the latter from said base,

D. and draft means

1. for connecting said wheel unit selectively to
   a. said tractor unit
   b. and to other means of motive power,
2. for moving said wheel unit from a position underlying said trailer base.

The '636 Patent.

The '636 patent claims a method of transferring the base or bed of a semi-trailer to a railway flat car. The method is related to the '889 patent in that it can be used with detachable-bogie, tractor-trailer assemblies of the

type therein described. Again, infringement was broadly alleged in the complaint, but the District Court indicated that, of the fifteen claims of the patent, only claims 1, 3, 4, 11, 12, 14 and 15 were in issue.

Claim 1 is descriptive of one embodiment of the invention and reads (reference letters and breakdown ours):

> 1. The method of transferring a trailer body from a trailer having a removable attached undercarriage, the trailer body having a king pin on the front end thereof and swivel means located rearwardly of the king pin cooperating with swivel means on the floor of the flat car when the two swivel means are brought into registry, also including the use of a towing vehicle, said method including the steps of
>
> a. backing the rear end of the trailer body upon the side of the flat car,
>
> b. registering the swivel means on the flat car to form a pivot,
>
> c. locating a towing vehicle to one side of the front end of the trailer body,
>
> d. attaching the towing vehicle to the front end of the trailer body and relieving the weight of the trailer body from the tractor and undercarriage,
>
> e. removing the undercarriage from the trailer body,
>
> f. supporting the trailer body solely upon the flat car and upon the towing vehicle,
>
> g. swinging the trailer body by the use of the towing vehicle so as to align the longitudinal axis of the trailer body with the longitudinal axis of the flat car,
>
> h. disconnecting the towing vehicle from the trailer body so as to support the trailer body in direct contact with and upon the floor of the flat car,

i. and locking the king pin to the flat car to hold the front end of the trailer body in locked position upon the flat car.

From an examination of the foregoing claim, and in particular its preamble, which describes many of the structural features needed to carry out the claimed methods, it seems quite apparent that the trailer assembly described and claimed in the '889 patent would serve quite well in such a system, with certain structural modifications. It would be only necessary to equip the trailer base with a swivel means, for registry with the corresponding swivel means on the flat car, and with a king pin, for locking the trailer base in place once it is positioned on the flat car.

Claims 3 and 4 are very similar to claim 1 and need not be set forth in detail. Claim 11 defines essentially the same method, but in somewhat more general terms:

> 11. A method of making shipments through the utilization of rail and truck transportation and involving the use of a railway flat car and a semi-trailer having a load-carrying bed detachably connected at its front end to a tractor unit and having a stable multiple axle wheel unit provided with an upper portion detachably locked in position underneath the rear part of the bed whereby the latter is conjointly supported by said wheel and tractor units for movement along a roadway, said method including the steps of backing the semi-trailer by means of the tractor in a direction generally normal to the longitudinal axis of the railway flat car to a position wherein the rear end of said bed adjoins and is generally level with the adjacent upper surface of said flat car and wherein the rear set of wheels of said wheel unit adjoins the side of said flat car, stopping the backing movement of said tractor unit and unlocking said wheel unit from said load-carrying bed to permit relative movement therebetween, then continuing the backing

movement of said tractor unit while said wheel unit is held stationary to push against the forward end of said bed and thereby move said bed smoothly over the horizontally stable upper portion of said stationary wheel unit and onto said flat car to transfer support of the load from said wheel unit to said flat car, the wheel unit by reason of its stability remaining horizontal and untilted and permitting unobstructed movement of said load-carrying bed relative to said wheel unit without considerable separation therebetween, disconnecting said tractor unit from said bed, and swinging said bed horizontally and relative to said flat car to a position wherein its longitudinal axis is generally aligned with the longitudinal axis of the flat car.

Claims 12, 14 and 15 are dependent upon claim 11 and add many of the structural details of claims 1, 3 and 4, albeit in terms of functional method "steps."

The beneficial features of the system described by Felburn should be readily apparent. A truck-borne cargo can be quickly and easily transferred for rail transport, without unloading, leaving the tractor and running gear of the semi-trailer immediately free for further service.

We shall consider first the issue of validity of the two patents in suit, for an affirmance of the District Court on that score would obviate the need for consideration of the infringement issue. *National Transformer Corp. v. France Mfg. Co.*, 215 F. 2d 343, 102 USPQ 331 (6th Cir. 1954). Cf. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U. S. 327, 330 (1945).

Validity.

As a preliminary matter, we note that the District Court, in its conclusions of law numbered 8 and 9, held both patents "invalid and void for lack of novelty and

patentable invention," without restricting that holding to the particular claims on which the issues were tried. We think it was error for the District Court, even impliedly, to pass upon the validity of claims which were not properly put in issue. *Bain v. M. A. Hanna Co.*, 331 F. 2d 974, 141 USPQ 559 (6th Cir. 1964). See also *Chemical Construction Corp. v. Jones & Laughlin Steel Corp.*, 311 F. 2d 367, 136 USPQ 150 (3d Cir. 1962). While a different result might well obtain where there is a claim or counterclaim seeking a declaratory judgment of invalidity of the entire patent, see *Sterling Aluminum Prods., Inc. v. Bohn Aluminum & Brass Corp.*, 187 F. Supp. 879, 127 USPQ 104 (E.D. Mich. 1960), aff'd, 298 F. 2d 538, 132 USPQ 365 (6th Cir. 1962) and *Kawneer Co. v. Pittsburgh Plate Glass Co.*, 103 F. Supp. 671, 93 USPQ 3 (W.D. Mich. 1952), we do not have that situation in the present case. Accordingly, insofar as it purports to hold invalid claims 1, 2 and 4 of the '889 patent, or claims 2, 5-10 and 13 of the '636 patent, we *vacate* the order of the District Court. Cf. *Goodwin v. Carloss Co.*, 116 F. 2d 644, 48 USPQ 403 (6th Cir. 1941).

The District Court found the patents in suit to be invalid for lack of "novelty" *and* "patentable invention." The statutory bases for such a finding are 35 U.S.C. 102 and 103. In the view we take of the case, however, there appears to be novelty in the semi-trailer and tractor assembly defined in claim 3 of the '889 patent and in the method defined in claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent, when tested according to the provisions of section 102. That is to say, the inventions claimed in these claims are not "identically disclosed" in the prior art of record. We have arrived at this conclusion after an examination of the cited prior art in the light of the testimony herein and after giving due weight to the findings of fact which were proposed by the defendants and adopted by the trial court.

Thus, the District Court, in its Finding of Fact No. 14, found:

> 14. The entire combination recited in Claim 3 of the '889 patent is applicable to the conventional semi-trailer combinations with sliding bogies which were in prior use, except for the following two allegedly novel elements:
>
> A. A "depending cam surface" at the rear portion of the trailer base engageable with a load carrying platform of a vertical height slightly higher than that of said rear portion whereby the tractor unit may back the trailer base against the said platform with sufficient force to cam said rear portion upwardly to overlie said platform so that the rear end of the trailer base is removed from the bogie.
>
> B. Draft means for connecting the bogie to the tractor for moving the bogie "from a position underlying said trailer base."

In Finding of Fact No. 56, the court stated:

> 56. All of the steps recited in Claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent were old, having been disclosed in prior patents and publications, in which they were employed in essentially the same way and for the same purpose. No new or unexpected result was achieved by Felburn's combination of these old steps into the methods claimed, and no ingenuity beyond that of an ordinary mechanic was involved in making such combination.

These findings seem, by their very terms, to require the conclusion that the claims are not invalid for want of *novelty* under section 102.

However, novelty alone will not support validity of the claims. Section 103 provides, in pertinent part, that:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences be-

> tween the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

Patents when issued by the Patent Office are "presumed valid" (35 U.S.C. 282). Where, however, what we consider to be pertinent prior art was not before the Patent Office, the presumption of validity does not apply with respect to such prior art. *Royal Patent Corp. v. Monarch Tool & Mfg. Co.*, 203 F. 2d 299, 97 USPQ 196 (6th Cir. 1953).

As to claim 3 of the '889 patent, the McGregor U. S. Patent No. 2,543,295 was not cited by the Patent Office, although, despite the contrary statement in the District Court's Finding of Fact No. 60, this patent was cited as a reference against the application which matured into the '636 patent. Thus, as to the '889 patent, there is no presumption of the validity of claim 3 over the McGregor patent.

We think the pertinent facts concerning the McGregor patent disclosure were properly stated in the District Court's Finding of Fact No. 50, which reads as follows:

> McGregor discloses a semi-trailer and tractor unit assembly including a trailer with its forward end removably supported by a tractor unit, and with a wheel unit adapted to support the rear portion of said trailer whereby the trailer is conjointly supported by the wheel and tractor units for movement along a roadway, the wheel unit being detachable from the trailer. The rear portion of the wheel unit terminates in a depending cam surface which is engageable with the load carrying platform of a vertical height slightly higher than that of said rear portion, whereby the tractor may back the trailer and wheel unit assembly against the platform with sufficient force to cam the

rear portion upwardly to overlie the platform to provide for ready disassembly of the wheel unit from the trailer. McGregor also shows draft means connecting the wheel unit to the tractor for moving the wheel unit from a position underlying the trailer.

While there admittedly are verbal differences between the structure called for in claim 3 of the '889 patent and structure disclosed in the McGregor patent, we agree with the District Court's Finding of Fact No. 52 that:

> The result accomplished by the operation of McGregor's system is identical with that of the Fellabaum[3] '889 patent. McGregor leaves the trailer with its rear end supported at the edge of a loading platform and with its front end supported upon supporting legs, exactly as Fellabaum does.

It must be remebered that the technological art with which we are here concerned is highly developed, as indicated by the large number of prior art patents which have been cited. One of ordinary skill in this art could draw from the works of many prior patentees in the field. Thus, we agree with the portion of the District Court's Finding of Fact No. 48 that states:

> All of the elements recited in Claim 3 were old, having been employed in the freight handling systems disclosed in prior patents, in which they functioned in the same way and for the same purpose. * * *

In addition to the McGregor patent teachings, one of ordinary skill in this art would have had before him the knowledge disclosed in the Menning U. S. Patent No. 2,151,640, the Zubatsky U. S. Patent No. 2,369,384 and the Alexander U. S. Patent No. 2,038,156. All these patents issued long prior to the date when the invention of patent '889 was made. Thus, the issue to be decided is solely

---

[3] See fn. 1, *supra*.

whether the differences between the invention *as claimed* in claim 3 of the '889 patent and the prior art are such that the invention as a whole would have been obvious to one of ordinary skill in this art under the conditions stated in 35 U.S.C. 103. What slight differences there may be between the structure defined by the language of claim 3 of the '889 patent and that shown in the McGregor patent are such that in our opinion the invention of claim 3 taken as a whole would have been obvious in view of the disclosures of the additional patents, which were cited as references against the application which matured into the '889 patent. We find the factual support for this conclusion stated in the District Court's Findings of Fact Nos. 53 and 55:

> 53. The Menning U. S. Patent No. 2,151,640, which was issued in 1939, discloses a truck supporting a removable cargo body. The rear end of the cargo body is adapted to engage a cam surface on a bumper block at the edge of a loading platform, whereby the truck can back the cargo body against the cam surface and cam it up onto the loading platform to remove its weight from the truck. Then the truck can drive away, leaving the rear end of the cargo body supported by the load carrying platform and its forward end supported by jacks. Thus, the end result accomplished by Menning is identical with that accomplished by Fellabaum in his '889 patent system.
>
> 55. There was nothing novel about either a truck and semi-trailer combination or a separate hitch. A semi-trailer assembly with a slidable bogie is shown by the prior Zubatsky U. S. patent No. 2,369,384 issued in 1945, while the hitch means is shown by the prior Alexander U. S. patent No. 2,038,156 issued in 1936.

We therefore agree that claim 3 of the '889 patent is invalid on the basis that it does not meet the conditions

for patentability specified in 35 U.S.C. 103. We therefore amend the District Court's conclusion of law No. 8 to read as follows:

> 8. Claim 3 of Patent No. 2,693,889 is invalid as not meeting the conditions for patentability specified in 35 U.S.C. 103.

The statutory presumption of validity as to claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent is rebutted by the fact that pertinent prior art was not before the Patent Office in connection with the applications which resulted in the '636 patent. Here we refer particularly to the Winn U. S. Patent No. 1,541,457 issued in 1925 and to the evidence of the Behrens work in this field. With respect to the Winn patent, we agree with the District Court's Finding of Fact No. 57:

> 57. The Winn U. S. patent No. 1,541,457, issued in 1925, was not cited by the Patent Office against any of the applications for the '636 patent. It discloses a semi-trailer and tractor assembly in which the front end of the trailer bed is detachably connected to the tractor through the semi-trailer frame with a multiple axle wheel unit supporting the rear portion of the trailer bed. Winn further discloses the loading of the cargo bodies onto a railroad car having turntables rotatably mounted thereon by the successive steps of: rotating the turntables to a position transverse of the railroad car, backing the trailer by means of the tractor until it is adjacent the side of the railroad car, unlocking the cargo bodies from the wheel unit, pushing the cargo bodies smoothly over the wheel unit and onto the railroad car, and rotating the turntables and cargo bodies to a position parallel to the railroad car.

Referring to claim 11 of the '636 patent as representative, it will be seen that Winn discloses everything there

claimed except (1) the use of a conventional "flat car," (2) the backing of the cargo bodies into actual contact with the railroad car, and (3) the use of the tractor for pushing the cargo bodies onto the rail car.

When, however, we consider that the teachings of the prior Zubatsky U. S. Patent No. 2,369,384 had been available since 1945 and the teachings of the prior McGregor U. S. Patent No. 2,543,295 had been available since 1951, we think it would have been obvious for one of ordinary skill in this art to add to the method described by Winn the operative steps described by Zubatsky and McGregor. Thus Zubatsky discloses the step of using a tractor to push a trailer from its removable bogie onto a conventional flat car, while as previously pointed out, McGregor discloses the backing of the trailer of a semi-trailer and tractor assembly by the tractor in a direction generally normal to the axis of a rail car until the rear end of the trailer adjoins and is generally level with the rail car and the wheel unit adjoins the side of the rail car. Then the wheel unit is unlocked from the trailer, and the trailer is slid onto the rail car by movement of the tractor, the wheel unit being simultaneously pulled from beneath the trailer. The trailer is then rotated on the turntable to a position in which its longitudinal axis is parallel to the longitudinal axis of the railroad car.

Details of the method of the '636 patent covered in the other claims in suit are found in other references of record which were available at the time Felburn made the invention of the '636 patent. We think this aspect of the case was correctly stated by the District Court in its Findings of Fact Nos. 63 and 64:

> 63. The additional step of registration of swivel means on a trailer with swivel means on a railroad car to form a pivot for rotation of the trailer to a position

parallel to the car, as recited in Claims 1, 3, 4, 14 and 15 of the '636 patent, was not new, but is disclosed in the prior Ross U. S. patent No. 1,734,303 issued in 1929, and in the prior Francis U. S. patent No. 1,968,-196 issued in 1934.

64. The additional steps of attaching a towing vehicle to one side of the front end of the trailer bed and using the towing vehicle to swing the trailer bed to a position parallel to the flat car, as recited in Claims 1, 3, 4 and 12 of the '636 patent, were not new, but are disclosed by a number of prior patents including the aforementioned Francis patent, the Nelson U. S. patent No. 2,782,054 issued in 1957 on an application filed in 1953, and the Gutridge U. S. patent No. 2,819,687 issued in 1958 on an application filed in 1953.

We recognize and have considered appellant's arguments against such use of these references. It is difficult in the usual case, in applying the test Congress has enunciated in 35 U.S.C. 103, to avoid the charge of a "hindsight" reconstruction of the art. See, e.g., *In re Seevers,* 52 CCPA ____, 346 F. 2d 602, 145 USPQ 694 (1965). Here, however, we have the advantage of the Behrens testimony and disclosure which, while not a technical "anticipation" of the '636 patent under section 102, is, we think, pertinent evidence bearing upon what a person of ordinary skill in the art could be expected to evolve without having knowledge of the Felburn invention. Under the circumstances of this case we think it would be gross error to rely solely upon our own speculation as to what the art taught one of ordinary skill at the time Felburn made the invention of the '636 patent, when we have the advantage of considering what Behrens did. Judge Learned Hand, referring to the tests required under 35 U.S.C. 103, in *Reiner v. I. Leon Co.*, 285 F. 2d 501, 128 USPQ 25, 27 (2d Cir. 1960) stated:

> The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person "having ordinary skill" in an "art" with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, "obvious" is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e.g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant? * * *

Behrens testified before the District Court, and we think substantial weight should be given to the District Court's Finding of Fact No. 65 concerning it. No. 65 states:

> Rudolf Behrens, the proprietor of a German trucking firm, published a brochure disclosing a freight handling system which is virtually identical to that described in the broadest claims of the '636 patent. The first edition of this brochure was printed in June 1955 and was mailed out during the latter part of 1955. The second edition was sent out shortly thereafter, with all the mailing being completed within four months after December 1955, before the filing date of Felburn's first application for the '636 patent. One or the other of these two versions of the publication was sent to one hundred firms in Europe and to forty-two firms in the U. S. A., including the leading manufacturers of trucks and trailers, railroads and trucking companies.

We are not here concerned with the Behrens brochure as a technical "publication" under section 102. Rather, our concern is solely with what the Behrens testimony and

brochure establish as the independent development of one skilled in this art. It seems clear from the Behrens testimony that prior to the filing date of the '636 patent, he had disclosed an independent development which embodied the method claimed in the claims in issue of the '636 patent. Standing alone, there is danger in the acceptance of such evidence as being conclusive on the issue of obviousness under section 103. When, however, it is considered in the context of the present record as a whole, we think it is both pertinent and helpful to the court despite the admitted question as to whether the brochure qualifies as a publication under section 102—an issue which we do not here pass upon. Instead, we find in Behrens' testimony *and* the brochure credible evidence of an independent development of the subject matter of the '636 patent by a third party, which we here regard as persuasive that the claimed invention would have been obvious to one of ordinary skill in this art. See *Lempco Prods., Inc. v. Simmons,* 140 F. 2d 58, 60 USPQ 356 (6th Cir. 1944).

The evidence of Behrens' activity was not before the Patent Office during the pendency of the several applications which finally resulted in the issuance of the '636 patent. The pertinency of such activity is apparent from the District Court's Finding of Fact No. 67:

> 67. The Behrens publication illustrates a semi-trailer and tractor assembly in which the bogie is slidable along the bottom of the trailer and removable therefrom for loading of the trailer onto a conventional railroad flat car. The trailer is backed up by the tractor transversely of the flat car to a position wherein the rear end of the trailer adjoins and is generally level with the upper surface of the flat car. At this point, the trailer is unlocked from the bogie to permit sliding of the bogie along the undersurface of the trailer. Then the backing of the tractor is resumed

> to push the rear end of the trailer onto the turntable. The rear end of the bogie engages the side of the flat car to prevent movement of the bogie as the trailer is slid onto the flat car. In one embodiment, shown in Figure 2 of the drawings of the publication, the trailer is pushed to a position wherein it is centered over the flat car. Thereupon, the front end of the bogie is connected to the rear end of the tractor by means of a hitch and the bogie is pulled by the tractor from beneath the trailer. Then the trailer is rotated to a position parallel to the freight car.

Our only comment on the above finding is that we are not considering Behrens' brochure as a "publication" meeting the technical requirements of section 102. The brochure illustrates and describes Behrens' knowledge of the problems to which Felburn addressed himself in the '636 patent and Behrens' independent solution thereof. Here, also, we are not concerned with whether Felburn or Behrens was the first inventor of the same invention, hence we are not concerned with whether or not Felburn reduced his invention to practice before Behrens did. We repeat, lest there be any future confusion as to our position on this matter, that we consider the evidence of the Behrens activity as a part of the record as a whole on the single issue of obviousness under the conditions specified in 35 U.S.C. 103. Even if we accept the unsupported and uncorroborated testimony of Felburn that he made the models (Plfs. Ex. 10-14) "in the summer of 1954," this does not change the fact that the art was already highly developed at that time, as evidenced by the numerous earlier patents to which we have previously referred. It seems clear to us that when Felburn and Behrens, working independently, attacked the same problems at about the same time and arrived at the same solutions it is *some*

evidence, cumulative to be sure, which supports our view that the ordinary skills in this art were such that the invention patented in the '636 patent would have been obvious to the hypothetical person postulated in section 103 and under the conditions stated therein.

We agree with the decision of the District Court that claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent are invalid but we do so solely on the basis that they do not meet the conditions for patentability specified in section 103. We therefore amend the District Court's Conclusion of Law No. 9 to read as follows:

> 9. Claims 1, 3, 4, 11, 12, 14 and 15 of Patent No. 3,002,636 are invalid as not meeting the conditions for patentability specified in 35 USC 103.

In the view we have taken of this case, it is not necessary to pass upon the issues of infringement tried below. There can be no infringement of an invalid patent. *National Transformer Corp. v. France Mfg. Co., supra.*

Summary.

For the foregoing reasons, the conclusions of law of the District Court are modified in the following particulars:

1. The determination of invalidity is restricted to the claims in issue, i.e., claim 3 of the '889 patent and claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent, and
2. The claims in issue are invalid as covering inventions which we find do not meet the conditions for patentability set forth in 35 USC 103.

When so modified, the judgment is affirmed. See *Goodwin v. Carloss Co., supra.*

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In the Supreme Court of the United States

OCTOBER TERM, 1965.

No. 772.

JOHN PHIL FELBURN,

Petitioner,

vs.

THE NEW YORK CENTRAL RAILROAD COMPANY, and FRUEHAUF TRAILER COMPANY,

Respondents.

PETITIONER'S SUPPLEMENTAL APPENDIX

Containing Excerpts From Defendant-Appellee's Physical Exhibits J-1 and K-1 and Identifying Excerpt from Record.

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Containing Excerpts From Defendant-Appellee's Physical Exhibits J-1 and K-1 and Identifying Excerpt from Record.

STATEMENT.

The Excerpts printed hereinafter in this Supplemental Appendix are from the Printed Record and Physical Exhibits on file in the Supreme Court of the United States.

DEFENDANT-APPELLEE'S PHYSICAL EXHIBIT J-1.

(Translation of Behrens Patent No. 1,053,411.)

Federal Republic of Germany. German Patent Office
Class 81e 120

Specification 1,053,411 B 35462 XI/81e
Internat. Class B 65 g

Date of application: April 23, 1955. Announcement of the application and issue of the specification: March 19, 1959.

Process for the loading and unloading of road vehicles to be shipped on railroad cars, and transport vehicle to carry out the process.

Applicant: Rudolf Behrens, 192b Niedergeorgswerder-deich, Hamburg-Wilhelmsburg.

Rudolf Behrens, Hamburg-Wilhelmsburg, has been named as the inventor.

* * * * *

CLAIMS

1. Process for loading and unloading of road vehicles to be shipped on railroad cars, particularly of multi-axle trailers and semi-trailers with sets of wheels detachable from the carriage, which are readied on a track which lies in the same or nearly the same plane as the rails, characterized in that the carriages with the part containing the load, on changing from the road to the railroad travel, is brought without its set of wheels onto the railroad car in such a way that the carriage is pushed directly from at least one of its sets of wheels and is pushed crosswise to the railroad car at least to its longitudinal center of gravity, and leaving behind the other set of wheels or of the tractor vehicle is so swiveled on the railroad car platform that its longitudinal axis, as is familiar in itself with road-reversal vehicles, runs parallel to the longitudinal axis of the track, while one taking up the highway travel again the part of the road vehicle loaded on the train is taken over by a set of similar or fitting sets of wheels in reverse sequence.

* * * * *

TESTIMONY OF RUDOLPH BEHRENS (R. 135a).

Q. Are you the Rudolph Behrens who is the patentee of this German Patent No. 1,053,411 (handing exhibit to witness)? A. Yes.

Q. Have you written any publications relating to the same subject matter as this German patent? A. Yes, in the Journal Schiene-Strasse.

Q. What does "Schiene-Strasse" mean in English, Dr. Perbix?

The Interpreter: It means rail-street—rail-road.

Mr. Conner: Rail and road?

The Interpreter: That's right, transportation by means of rails and transportation by means of road, in that sense.

Mr. Conner: I ask the Clerk to mark as Defendants' Exhibit K a copy of the bulletin Schiene-Strasse.

EXCERPTS FROM DEFENDANT-APPELLEE'S PHYSICAL EXHIBIT K-1.

(Translation of Behrens Brochure.)

RAILS-ROADS AND THE SOLUTION OF THIS PROBLEM USING THE TVB TRANSFER SYSTEM.

Since the beginning of transportation with motor vehicles a competition started between the railroads and motorized vehicles. This struggle cost many millions and in many countries the further development and use of trucks is slowed down. Many billions are invested in the railroads and they employ large numbers of people. Therefore, the extinction of railroads would disturb seriously the economy of the respective countries.

* * * * *

Besides this, experiments were made to combine both systems. Besides the use of small containers up to five ton capacity, the so-called piggy-back transportation is used. Special vehicles which are able to roll on the streets or on rails without complicated manipulations and can carry loads up to five tons, are in use.

The so-called piggy-back transportation was introduced in the United States already in the twenties and its use expanded after the construction of the saddle-carrier. A number of railroads discontinued this type of transportation while some continued up to date. This system, however, could not be developed satisfactorily even in the United States.

The reasons for this are the following:

1. The loading of trucks onto the cars is difficult and time-consuming.

2. The loading can be done only using special cars and railroad ramps at the end and sides heaving the height of the car platform.

3. The car capacity is not satisfactorily used with this system.

4. Many trucks, particularly the valuable closed vans, are too high for the existing bridges, after loading them on the cars.

5. The time needed for loading and unloading depends on shunting facilities of the railroads, and is often connected with unnecessary time losses.

6. The different loaders and unloaders interfere one with the other, since it is impossible to service them independent of the others. The last car must be unloaded first after arrival, while all others must wait their turn.

* * * * *

The Requirements to Be Considered for the Solution of the Problems, and Achievements Through the Use of the TVB System.

The requirements are as follows:

1. Predominantly saddle carriers and pick-ups of existing construction with all the usual characteristics, such as low weight, high speed, high shunting capabilities, rugged and simple construction, should be used.

2. The additional weight of the construction needed for the transfer of the load carrying pick-up to a car should not exceed 1,200 kilograms.

3. The extra cost of the pick-up so equipped should not exceed DM 6,000.

4. This construction should not be made of complicated

5. There should be no parts requiring additional space or shortening the loading length.

6. The transfer of the load carrying pick-up should not require additional labor besides the drivers. The construction must be fool-proof and the sequence of operations must be so interlocked that the transfer could be done also by unskilled labor without danger of accident.

7. The railroads should not ask for additional services, in particular no additional shunting work or technical adaptations. The only exception would be works in the yard which the railroad can always do with local unskilled labor.

8. In cases where a mixed freight train, having for example about 40 platform cars, stands at the loading street, it must be possible for every carrier to load or unload his pick-up independently of others.

9. The carrying capacity of a pick-up should be minimum 15 tons.

10. In order to reduce the expenses, the load carrying companies should be permitted to use their pick-ups for advertising of their services.

In agreement with the above requirements, the TBV System uses saddle carriers of the usual construction and size. They carry 10 to 20 ton loads. The additional mechanism does not project beyond the body, is built simply and rugged, without easy-to-damage parts. These pick-ups do not require any special additional installations at the railroad. The only exception is that the width of the loading street is adequate to permit an approach of the hauler under approximately right angle to the car and the distance between road and car platform would be approximately the same along the street. The height of the loading street should be about 15 centimeters above top of rails. This can be done easily by using local labor. In large city terminals, space for these loading streets can be easily provided by removing a double rail without decreasing the present transfer capacity.

* * * * *

This system permits free movement to the hauler. It enables a step by step introduction without larger expenditures by the railroad. As long as the railroad maintains piggy-back transportation, for example, as between Hamburg—Frankfurt or Muelheim, a carrier having offices in both cities can start out with this system. There are long distance haulers or carriers transporting every day up to 15 loads from the Rhine provinces to Hamburg and back. Using this system, their earnings will increase considerably as compared with the sending of those loads every night to Hamburg by rail.

It can be introduced also by the railroad in particular for the clients who are served now by a wagon roller. The so-called sidespur is one of the big losing enterprises, because in order to deliver to the client a 15 ton load, the following equipment is needed:

1 heavy locomotive of 15 ton weight
1 wagon roller of 10 ton weight
the car itself 9 tons net weight

Thus 34 tons of net weight must be transported which is about 22 tons more than for the TVB System.

Besides this, these transports require a police escort and interfere very much with the traffic. The delivery of the car or bringing it back on the railroad rails requires much time. With this system, the railroads could regain again 75 per cent of traffic they lost.

Further advantage for the railroad:

1. The railroad can stop its fight against the motor vehicles without asking for unpopular laws.

2. It is possible for the railroad to make a good profit granting the hauler the present piggy-back tariffs, because the railroad can move goods considerably cheaper.

* * * * *

The railroad can save thousands of cars because the unloading or transfer time would be only a fraction of the previous required time.

* * * * *

With the further development of the system, the railroad can limit the number of its shunting terminals which are very expensive to maintain since the TVB System is developed taking the future shunting requirements in consideration. It is for example possible to transfer the pick-

ups from a complete train within the shortest time moving along special transfer stands. They can also be very fast transferred to the cars eventually completely automatically.

* * * * *

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Respondents.

BRIEF AND APPENDIX FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Petitioner seeks a writ of certiorari to review that portion of the Judgment of the United States Court of Appeals for the Sixth Circuit ruling invalid all of the litigated claims of U. S. Patent No. 3,002,636.

Restatement of Question Presented for Review

Did the Court of Appeals and the District Court err in their concurrent ruling that the patented freight-handling method (which has never been used, either commercially or experimentally, by anyone including the patentee) was unpatentably obvious in view of (1) the fact that all of the steps of the patented method

were old, having been disclosed in prior patents, in which they were employed in essentially the same way for the same purpose, and (2) the fact that at least six months prior to the filing date of the first of petitioner's three successive applications for the patent in suit, a brochure published by another had illustrated and described the combination of these old steps to form the complete patented method?

Restatement of the Case

Petitioner's "Statement of the Case" varies in several significant respects from the facts as concurrently found by the District Court and the Court of Appeals.

Petitioner cites respondents' own advertising as claiming operational advantages for the patented freight-handling method. But this advertising related to respondents' accused "Flexi-Van" system, which has little in common with the method described in the patent claims. The District Court found that the patented freight handling system had never been used, either by the respondents[1] or by the petitioner himself.[1a]

The District Court also found that respondents' Flexi-Van system was developed entirely independently of petitioner;[1b] that the petitioner learned of respondents' system when it was publicly demonstrated with widespread publicity;[2] that petitioner thereafter abandoned his then-pending patent application containing claims directed to a clearly different series of

[1] Finding 24, p. A-6, *post*.
[1a] Finding 11, p. A-6, *post*.
[1b] Finding 7, p. A-5, *post*.
[2] Finding 8, p. A-5, *post*.

steps, and filed a continuation-in-part application with added drawings illustrating a modified system more similar to respondents', and with broader claims drafted for the obvious purpose of covering respondents' system, but these broader claims were rejected as unpatentable over the prior art and were cancelled by petitioner.[3]

The District Court also found that, during the subsequent prosecution of his patent application, petitioner repeatedly argued that his narrower remaining claims should be allowed over the prior patents cited by the Patent Office because these claims contained the very limitations which now prevent their applicability to respondents' accused system.[4]

The District Court further found that every step of the patented method was old, having been disclosed by prior patents in which they were employed in essentially the same way for the same purpose.[5]

All of these findings supporting the District Court's rulings of invalidity and non-infringment were either expressly affirmed or left undisturbed by the Court of Appeals.

The petition for certiorari does not mention any of the foregoing grounds of invalidity, but is based entirely upon the allegation of error in one other ground of invalidity. This concerns the Behrens brochure, which was printed in Germany and mailed to 142 leading U. S. and European firms in the transportation industry commencing in December, 1955, six months

[3] Finding 12, p. A-6, *post*.

[4] Findings 25-47, pp. A-7 to A-11, *post*.

[5] Findings 56-64, pp. A-11 to A-14, *post*.

prior to the filing of petitioner's original patent application.[6] It is not disputed that this brochure discloses a freight handling method which satisfies all of the limitations of the patent claims.

At the trial, petitioner attempted to prove that he had invented the patented method prior to the publication of the Behrens brochure, but the District Court found his proof inadequate.[7] Thus, petitioner's repeated references to Behrens as a "subsequent inventor"[8] are unsupported by the evidence and contrary to the undisturbed findings of the District Court.

The Court of Appeals did not deem it necessary to pass on this issue of alleged priority of invention, ruling that, at the very least, the Behrens brochure established the substantially contemporaneous "independent development" of another, and constituted further evidence that the combination of old steps employed in the patented method was not patentably inventive.[9]

Petitioner charges that the Court erred in treating Behrens as a person of "ordinary skill in the art,"[10] whereas he is, in fact, "a giant in the field"[11] whom petitioner equates with "an Edison or an Einstein".[11a] The record is devoid of evidence supporting any such eulogism.

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[6] Finding 65, p. A-14, *post;* Court of Appeals opinion, p. 28 of Petition.

[7] Finding 71, p. A-16, *post.*

[8] Petition, pp. 2, 4, 8.

[9] Court of Appeals Opinion, Petition, pp. 28-29.

[10] 35 U.S.C. § 103, Petition, p. 12.

[11] Petition, p. 6.

[11a] *Ibid.*

Petitioner incorrectly states[12] that the Court of Appeals based its opinion upon "speculation". To the contrary, the Court expressly stated that it need not "rely solely upon . . . speculation as to what the art taught to one of ordinary skill . . . when we have the advantage of considering what Behrens did."[13]

Reasons for Denying the Writ

The use of the Behrens brochure by the Court of Appeals was consonant with this Court's repeated ruling that substantially simultaneous and independent development by others should be taken into consideration in determining whether the invention would have been "obvious" to those of "ordinary skill in the art."

For example, in *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177, 185 (1925), this Court stated:

> "The adaptation independently made by engineers and builders of these familiar appliances to the movement and distribution of concrete cement in building operations and the independent patent applications, within a comparatively short space of time, for devices for that purpose are in themselves persuasive evidence that this use, in combination, of well known mechanical elements was the product only of ordinary mechanical or engineering skill and not of inventive genius. Atlantic Works v. Brady, 107 U. S. 192, 2 S. Ct. 225, 27 L. Ed. 438. It is but 'the suggestion of that common experience, which arose spontaneously and by a necessity of human reasoning, in the minds of

[12] Petition, p. 4.

[13] Petition, p. 27.

those who had become acquainted with the circumstances with which they had to deal.' Hollister v. Benedict Manufacturing Co., 113 U. S. 59, 72, 5 S. Ct. 717, 724 (28 L. Ed. 901)."

Thus, the question presented by the petition has already been settled, we submit properly, by this Court. No public interest whatever would be served by further appellate review in this case.

Moreover, the Behrens reference was not the only ground upon which the patent was ruled invalid; the patent was also ruled not to have been infringed by the respondents. A reversal by this Court would not therefore mean ultimate victory for petitioner. Thus the question presented is not likely to be of any consequence even to the litigants at bar.

Conclusion

The petition should be denied.

Respectfully submitted,

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APPENDIX

Findings and Conclusions of the District Court

IN THE

United States District Court

NORTHERN DISTRICT OF OHIO

EASTERN DIVISION

JOHN PHIL FELBURN,
Plaintiff,

vs.

THE NEW YORK CENTRAL R. R. CO.,
FRUEHAUF TRAILER COMPANY,
Defendants.

CIVIL ACTION
No. 36,021

FINDINGS OF FACT AND CONCLUSIONS OF LAW

Findings of Fact

Nature of the Case

1. This is an action for infringement of two U. S. patents, Nos. 2,693,889 and 3,002,636, which were issued to and are owned by plaintiff, and which relate to freight handling equipment and methods. The Complaint charges infringement of both of the two patents in suit by the "Flexi-Van" freight handling system, in both its original and its modified "Mark III" versions, as used by defendant New York Central Railroad, employing equipment manufactured by defendant Fruehauf Trailer Company.

2. The Answer denies infringement of both patents, and alleges that both patents are invalid because the alleged inventions respectively covered thereby were not new and did not involve patentable invention.

The Patents in Suit

* * * * *

4. The Felburn patent No. 3,002,636 relates to a method of transferring the trailer bed of a semi-trailer and tractor assembly having a detachable wheel assembly or bogie to a railway "flat car" by the successive steps of: backing the trailer bed by means of the tractor in a direction generally perpendicular to the longitudinal axis of the flat car to a position wherein the rear end of the bogie engages the side of the flat car; removing the locking pins in the tow bars to permit telescoping of the tow bars; backing the tractor to push the trailer smoothly over the bogie and onto the floor of the flat car to the point where a V-shaped slot at the bottom of the trailer is engaged with a kingpin projecting upwardly from the flat car to form a pivot for rotation of the trailer on the flat car; attaching a separate towing and lifting vehicle to the front of the trailer to relieve the weight of the trailer from the tractor and bogie and support the trailer solely upon the flat car and the towing vehicle; and swinging the trailer by the towing vehicle to a position wherein the trailer is aligned with the flat car.

Of the fifteen claims of the '636 patent, three (Claims 11, 14 and 15) are charged to be infringed by the original Flexi-Van system, and seven (Claims 1, 3,

4, 11, 12, 14 and 15) are asserted against the Mark III system.

The Accused Flexi-Van Systems

5. The original Flexi-Van system employs a specially built railroad car having a rotable turntable which is raised and lowered by means of a hydraulic jack. The frame of the railroad car consists of a single, relatively narrow girder, the ends of which rest upon the wheel trucks of the car and the central portion of which is recessed to receive the turntable. The bogie is slidable on rails extending lengthwise of the undersurface of rear portion only of the trailer. The turntable is provided at its upper surface with a pair of skids which are also adapted for sliding engagement with the rails on the trailer.

To load the trailer onto the railroad car, the turntable is rotated to orient the skids transversely of the car. The trailer is then backed by the tractor transversely of the railroad car to a point opposite the ends of the skids on the turntable. Then the bogie is unlocked from the trailer and the tractor is backed to push the trailer smoothly from the bogie onto the skids of the turntable to a position wherein the trailer is centered lengthwise on the turntable. Thereupon the tractor is disconnected from the trailer, and the turntable is raised by the hydraulic jack to lift the trailer off of the bogie. The turntable is then rotated by hand to align the trailer with the railroad car, whereupon the hydraulic jack is again actuated to lower the trailer to a point where its two ends are supported on the railroad car and the depending kingpin at the front end of the

trailer is lowered into a recess on the railroad car to lock the trailer against rotation.

After the trailer has been lifted off the bogie and rotated parallel to the railroad car, the bogie may then be connected to the tractor and hauled away for other use. This is accomplished by a removable towbar which is temporarily attached to the bogie during the towing operation, and which is provided at its forwardly projecting end with a cam surface which is engaged by the tractor as the tractor is backed up toward the bogie, thereby raising the front wheels of the bogie off the ground to permit turning of the bogie without scrubbing of the tires.

6. In the Flexi-Van Mark III system, the railroad car is generally similar to that used in the original Flexi-Van, except that no hydraulic jack is provided for raising and lowering the turntable. Instead, the outer ends of the skids on the turntable are provided with inclined surfaces which engage the rear end of the trailer as it is backed onto the turntable by a special "Commando" tractor to cam the trailer up off of the bogie. The trailer is not backed to a balanced position on the turntable, as in the original Flexi-Van, but only to the point where its rear end is supported on the turntable. During this operation, the fifth wheel of the tractor is raised by a built-in hydraulic jack to lift the front end of the trailer up to the same height as its rear end. A transversely extending nose wheel mounted for vertical movement at the front end of the tractor is then lowered into contact with the ground, raising the regular front wheels of the tractor off the ground. This nose wheel

is rotated to swing the front end of the tractor in a circular arc around to a position where the tractor is perpendicular to the front end of the trailer. Then the nose wheel is raised out of engagement with the ground, lowering the front wheels of the tractor again to the ground, and the tractor is backed to swing the front end of the trailer around to a position adjacent the railroad car. At that point, a special hydraulic ram on the tractor pushes the front end of the trailer the remaining short distance to the point where the trailer is parallel to the railroad car.

After the trailer is thus removed from the bogie, the bogie is carried away on hinged arms at the rear end of the "Commando" tractor, these arms being extended and inserted beneath the bogie and raised to lift the bogie completely off the ground.

7. The two Flexi-Van systems were conceived and developed by Leo L. Mellam, President of New York Central Transport Company, in conjunction with engineers of the Strick Division of Fruehauf Trailer Company. Their work was done entirely independently of Felburn, and they obtained a number of patents of their own covering the basic system and the components thereof.

8. In early 1947, a set of experimental equipment for the original Flexi-Van system was constructed. This equipment was publicly demonstrated in New York during the first week in May 1957, with resulting widespread publicity. Some of the publications describing the Flexi-Van system came to the attention of Felburn himself.

9. In April, 1958, the Flexi-Van equipment went into regular commercial service on the New York Central.

10. During the latter part of 1960, after several years of use of the original Flexi-Van equipment, the Mark III equipment was designed and developed, to achieve several operating advantages over the original equipment. The Mark III equipment went into use in mid-1961; when the manufacture of this new equipment was commenced, production of the original Flexi-Van equipment was substantially terminated.

11. Felburn, although the head of both a truck-trailer equipment manufacturer and a trucking company, admittedly never used either of his two systems commercially. He did contact a large number of railroads and equipment manufacturers in an attempt to interest them in his various freight handling ideas, but without any success.

12. After he learned of the original Flexi-Van system, Felburn added a new sheet of drawings to one of his three applications for the '636 patent, showing a method more similar to the Flexi-Van system than that which he had previously disclosed, and he also added a number of broader claims which were obviously intended to cover Flexi-Van, but all these claims were rejected and ultimately cancelled.

Infringement

* * * * *

24. The claims of the Felburn '636 Patent in suit are not applicable to the methods performed in either of the two Flexi-Van systems.

25. Neither Flexi-Van system employs a "Flat-Car" as called for in all of the claims of the '636 Patent.

26. An interpretation of the expression "flat-car" sufficiently broad to cover the specially designed railroad cars employed in the two Flexi-Van systems would be inconsistent with the limited definition which Felburn applied to the expression during the prosecution of his applications for the '636 patent, in order to persuade the Patent Office to grant the patent.

27. After all of the claims of his first application for the '636 patent had been rejected by the Patent Office, Felburn amended the specification to define the expression "Flat car" as used in his claims, as a "railway car wherein the platform lies in a common plane throughout the load carrying area . . .".

28. As limited by this definition, the term "flat car" would not apply to the special railroad cars used in either of the two Flexi-Van systems, since neither rail car has an upper surface which "lies in a common plane".

29. During prosecution of his three applications for the '636 patent in suit, Felburn repeatedly told the Patent Office that his invention involved the use of "conventional flat bottom flat cars" and therefore differed from prior systems involving expensive, specially constructed flat cars having special attachments which reduced their utility for other purposes.

30. Felburn also repeatedly told the Patent Office that adding a turntable to a conventional railroad flat

car was contrary to his concept, since such a modification would add to the height and cost of the car, even to the point of rendering the cost "prohibitive." He even stated expressly that a railway car which is provided with a turntable is not the "equivalent" of the "flat car" called for in his claims.

31. Felburn also told the Patent Office that a car which had a compensating recess to lower the height of the trailer on the car is not a "flat car" within the meaning of his claims.

32. Felburn further repeatedly and emphatically told the Patent Office that according to his invention the trailer bed is rotated while in "direct contact" with the floor of the flat car.

33. As thus limited to the loading of trailers onto conventional flat bottom flat cars without a turntable or other special equipment, the claims of the '636 patent do not apply to the specially built rail cars of the Flexi-Van systems, which have turntables, which have no load supporting floors, and are neither adapted for nor used for handling conventional loads.

34. In neither Flexi-Van system are swivel means under the trailer body registered with swivel means on the rail car to form a pivot, as called for in Claims 1, 3, 4, 14 and 15 of the '636 patent.

35. During prosecution of his applications for the '636 patent, Felburn argued that this language in his claims requires that a pivot-forming part be provided

on the bed of the trailer to cooperate with a complementary pivot-forming part on the flat car.

36. In neither Flexi-Van system is there any swivel means on the trailer body which is registered with swivel means on the rail car to form a pivot. Instead, the rail cars of both Flexi-Van systems are provided with rotatable turntables which are permanently mounted on the cars. In each system, the pivotal mounting for turntable exists before the trailer is placed on the car and is not formed by registering anything on the trailer with anything on the rail car.

37. Plaintiff's attempt to apply to the Flexi-Van systems the language of his claims which calls for registering swivel means to form a pivot is therefore inconsistent with his argument to the Patent Office that it "necessitates that a pivot forming part be provided on the bed of the trailer".

38. Neither Flexi-Van system involves the use of a towing vehicle in the manner described in Claims 1, 3, 4 and 12 of the '636 patent.

39. In the Mark III system, the swinging of the trailer body on the railroad car is accomplished by the same tractor which pushes the trailer body onto the flat car, rather than by a "towing vehicle" which relieves the weight of the trailer from the tractor, as called for in Claims 1, 3, 4 and 12.

40. In the Mark III system there is no towing vehicle which is "offset from the tractor", as more specifically recited in Claims 3 and 4.

41. In the Mark III system, there is no towing vehicle which performs the step of "lifting" the front end of the trailer to relieve its weight from the tractor as further recited in Claim 12.

42. In neither Flexi-Van system is the trailer bed backed to a position wherein the rear end of the bogie "adjoins" the side of the flat car, as called for in Claims 11, 12, 14 and 15 of the '636 patent.

43. This is another critical limitation in the claims because no such limitation appeared in any of the claims as originally filed, but it was added to the claims during prosecution in an attempt to obtain their allowance. After adding this limitation, Felburn argued to the Patent Office that the abutment of the bogie against the flat car constituted a significant distinction between his claimed invention and the prior art cited by the Patent Office.

44. In both the original Flexi-Van and the Mark III systems, by contrast, the backing of the trailer is stopped while the rear end of the bogie is still spaced from the ends of the skids on the turntable and the brakes on the bogie are locked before the backing of the tractor is resumed to shove the trailer body onto the turntable.

45. In the Mark III system, the trailer is not pushed "smoothly" over the bogie, and onto the railroad car "without considerable separation" between the trailer and bogie, as called for in Claims 11, 12, 14 and 15.

46. This is also a critical limitation in the claims because it was not present in any of the claims of the original application for the '636 patent as filed, but was added by amendment during prosecution of the applications in order to distinguish the claims from the prior art cited by the Patent Office.

47. In the Mark III system, by contrast, the trailer is cammed up off of the bogie by engagement of its lower rear corner with sloping surfaces at the outer ends of the skids of the turntable during backing movement by the tractor.

Validity

* * * * *

The Felburn '636 Patent

56. All of the steps recited in Claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent were old, having been disclosed in prior patents and publications, in which they were employed in essentially the same way and for the same purpose. No new or unexpected result was achieved by Felburn's combination of these old steps into the methods claimed, and no ingenuity beyond that of an ordinary mechanic was involved in making such combination.

57. The Winn U. S. patent No. 1,541,457, issued in 1925, was not cited by the Patent Office against any of the applications for the '636 patent. It discloses a semi-trailer and tractor assembly in which the front end of the trailer bed is detachably connected to the tractor through the semi-trailer frame with a multiple axle

wheel unit supporting the rear portion of the trailer bed. Winn further discloses the loading of the cargo bodies onto a railroad car having turntables rotatably mounted thereon by the successive steps of: rotating the turntables to a position transverse of the railroad car, backing the trailer by means of the tractor until it is adjacent the side of the railroad car, unlocking the cargo bodies from the wheel unit, pushing the cargo bodies smoothly over the wheel unit and onto the railroad car, and rotating the turntables and cargo bodies to a position parallel to the railroad car.

58. Winn discloses everything called for in Claim 11 of the '636 patent except (1) the use of a conventional "flat car," (2) the backing of the cargo bodies into actual contact with the railroad car, and (3) the use of the tractor for pushing the cargo bodies onto the rail car.

59. None of these missing features was novel at the time of Felburn's alleged invention. The prior Zubatsky U. S. patent No. 2,369,384, issued in 1945, discloses the use of a tractor to push a trailer from its removable bogie onto a conventional flat car. Claim 11 is thus fully anticipated by the combination of Winn and Zubatsky.

60. The McGregor U. S. patent No. 2,543,295, issued in 1951, discloses the backing of the trailer of a semi-trailer and tractor assembly by the tractor in a direction generally normal to the axis of a rail car until the rear end of the trailer adjoins and is generally level with the rail car and the wheel unit adjoins the side of

the rail car. Then the wheel unit is unlocked from the trailer, and the trailer is slid onto the rail car by movement of the tractor, the wheel unit being simultaneously pulled from beneath the trailer. The trailer is then rotated on the turntable to a position parallel to the railroad car.

61. McGregor discloses all of the steps recited in Claim 11 of the '636 patent in suit except (1) the use of a conventional "flat car" without a turntable, as defined by Felburn, and (2) the movement of the trailer onto the flat car by *backing* movement of the tractor while the wheel unit is stationary.

62. Both of these two features, lacking in McGregor, are disclosed by the prior Zubatsky patent. Thus, the entire combination of Claim 11 is also anticipated by the combination of McGregor and Zubatsky.

63. The additional step of registration of swivel means on a trailer with swivel means on a railroad car to form a pivot for rotation of the trailer to a position parallel to the car, as recited in Claims 1, 3, 4, 14 and 15 of the '636 patent, was not new, but is disclosed in the prior Ross U. S. patent No. 1,734,303 issued in 1929, and in the prior Francis U. S. patent No. 1,968,196 issued in 1934.

64. The additional steps of attaching a towing vehicle to one side of the front end of the trailer bed and using the towing vehicle to swing the trailer bed to a position parallel to the flat car, as recited in Claims 1, 3, 4 and 12 of the '636 patent, were not new, but are

disclosed by a number of prior patents including the aforementioned Francis patent, the Nelson U. S. patent No. 2,782,054 issued in 1957 on an application filed in 1953, and the Gutridge U. S. patent No. 2,819,687 issued in 1958 on an application filed in 1953.

65. Rudolf Behrens, the proprietor of a German trucking firm, published a brochure disclosing a freight handling system which is virtually identical to that described in the broadest claims of the '636 patent. The first edition of this brochure was printed in June 1955 and was mailed out during the latter part of 1955. The second edition, was sent out shortly thereafter, with all the mailing being completed within four months after December 1955, before the filing date of Felburn's first application for the '636 patent. One or the other of these two versions of the publication was sent to one hundred firms in Europe and to forty-two firms in the U. S. A., including the leading manufacturers of trucks and trailers, railroads and trucking companies.

66. This Behrens publication was not cited by the Patent Office against any of the applications for the '636 patent.

67. The Behrens publication illustrates a semi-trailer and tractor assembly in which the bogie is slidable along the bottom of the trailer and removable therefrom for loading of the trailer onto a conventional railroad flat car. The trailer is backed up by the tractor transversely of the flat car to a position wherein the rear end of the trailer adjoins and is generally level

with the upper surface of the flat car. At this point, the trailer is unlocked from the bogie to permit sliding of the bogie along the undersurface of the trailer. Then the backing of the tractor is resumed to push the rear end of the trailer onto the turntable. The rear end of the bogie engages the side of the flat car to prevent movement of the bogie as the trailer is slid onto the flat car. In one embodiment, shown in Figure 2 of the drawings of the publication, the trailer is pushed to a position wherein it is centered over the flat car. Thereupon, the front end of the bogie is connected to the rear end of the tractor by means of a hitch and the bogie is pulled by the tractor from beneath the trailer. Then the trailer is rotated to a position parallel to the freight car.

68. Every step recited in Claim 11 of the '636 patent in suit is fully anticipated by the system disclosed by Behrens.

69. The system disclosed by Behrens is fully operative. There are no defects in it except for omissions of routine construction detail which could be supplied by any mechanic. These details are the type which are frequently omitted from patent drawings, which may be merely a schematic indication of a principle of operation.

70. The Behrens publication constituted a printed publication disclosing the method covered by Claim 11 of the '636 patent which was published and distributed at least six months before the filing date of the first application for the '636 patent.

71. Felburn has not established either a reduction to practice of the invention of the '636 patent or any diligence toward such reduction to practice, prior to the filing date of his first application for such patent.

Conclusions of Law

1. This Court has jurisdiction of the subject matter and of the parties.

2. The patents in suit, being only "paper patents" which were never used commercially, should be strictly construed.

* * * * *

5. Plaintiff is estopped by his amendments and arguments before the Patent Office to contend that Claims 1, 3, 4, 11, 12, 14 and 15 of the Felburn U. S. patent No. 3,002,636 are applicable to the freight handling methods performed by defendants or with their equipment.

6. Said patent No. 3,002,636 has not been infringed by either of the defendants.

7. The failure of the Patent Office to cite the most relevant prior art against the applications for the patents in suit destroys the rebuttable presumption of validity which usually attaches to a granted patent.

* * * * *

9. Said patent No. 3,002,636 is invalid and void for lack of novelty and patentable invention.

PETITIONER'S REPLY BRIEF

Office-Supreme Court, U.S.
FILED
JAN 13 1966
JOHN F. DAVIS, CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1965.

No. 772.

JOHN PHIL FELBURN,

Petitioner,

vs.

THE NEW YORK CENTRAL RAILROAD COMPANY, and FRUEHAUF TRAILER COMPANY,

Respondents.

PETITIONER'S REPLY BRIEF.

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TABLE OF AUTHORITIES.

Cases.

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Cuno Engineering Corp. vs. Automatic Devices Corp., 314 U. S. 84; 62 S. Ct. 37 ---------- 4

Elliott vs. Youngstown, 181 Fed. 345 ---------- 5

Great Atlantic and Pacific Tea Co. vs. Supermarket Eq. Corp., 340 U. S. 147; 71 S. Ct. 127 ---------- 4

Statutes.

35 U. S. C. Sec. 103 ---------- 6

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PETITIONER'S REPLY BRIEF.

The Petition for Certiorari in effect asks the question, "who is the man of ordinary skill" to whom the bench and bar must look to determine the question of obviousness.[1] In answering this question, the Appellate Court looked to another inventor in determining who is the man of "ordinary skill." Such erroneous test was the basis for the Appellate Court's decision, and for the Petition. Respondents evade the issue and direct their attention instead to what the District Court found,[2] as though certiorari were being taken from the District Court's opinion, rather than from that of the Appeals Court.

Respondents' approach is not only improper in form and procedure, but it also disregards the Appeals Court reversal of the District Court's finding that the steps were not anticipated by the references and therefore were novel,

[1] Petition, page 2.

[2] Respondents' Opposition Brief, pages 2-4.

thereby leaving obviousness as the sole question.[3] Moreover, the Appeals Court did not "concurrently rule" as claimed by Respondents at pages 1-2 of their Opposition Brief. Such an assertion by Respondents is an erroneous statement of the Appellate Court Opinion. Respondents are attempting to substitute the ruling of the District Court for the ruling of the Appeals Court.

The decision on obviousness was based on the sole basis of "speculation" or by holding that because Behrens also discovered a portion of the invention, *a priori* it is not invention. We know that "speculation" is an improper test. This leaves us only with the proposition that because Behrens assertedly subsequently invented the concept, it is not invention—even though Behrens was himself an inventor and the holder of a later German patent on allegedly the same concept and where his brochure indicates the revolutionary character of his discovery.[4] Such an approach is question begging of the first degree.

Respondents' evasion of the central issue highlights Petitioner's case. When Respondents finally do turn to the Appeals Court decision, their quotation of the opinion supports Petitioner's position. Respondents repeat as their position the very same position which was taken by Petitioner. As stated at page 5 of the Respondents' Opposition Brief:

> "To the contrary, the Court expressly stated that it need not 'rely solely upon * * * speculation as to what the art taught to one of ordinary skill * * * when we have the advantage of considering what Behrens did.' "

This is exactly what Petitioner has been contending—that the Appeals Court based its decision either upon

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[3] Petition, Appendix, pages 20-21.

[4] Petition, pages 5-6.

speculation or upon what Behrens did.[5] Since Behrens was himself an inventor and held a late German patent on the same alleged invention, the Appeals Court based its decision upon the erroneous premise of looking to what is obvious to an inventor rather than to one of "ordinary skill." Moreover, there is no showing that the idea was even obvious to the inventor, Behrens. On the contrary, the German Patent Office and Behrens certainly did not think the idea obvious, as Behrens applied for and received a patent on his idea. Respondents have not denied that the patent and brochure indicate that the changes swept away the long existing difficulties of the prior art.[6]

The present case provides an excellent test case for determining the question of who is one of "ordinary skill" in the art. Respondents could find no other basis for the Appellate Court's decision. We have an Appeals Court that admitted that it must either speculate or look to Behrens. Thus, we have a case which sharply focuses upon the question of who is one of "ordinary skill" in the art—the question still undecided by this Court.

Respondents state that Behrens was neither an Einstein nor an Edison.[7] What is important is that he was clearly a person of more than ordinary skill. The Patent Act does not say "obvious to anyone other than a genius." It says, obvious to one of "ordinary skill." Behrens was certainly not a man of "ordinary skill." Significantly Respondents have never maintained, or been able to show from the record, that he was a man of ordinary skill.

Contrary to Respondents' assertion,[8] the reversal of this decision certainly would be of consequence to the liti-

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[5] Petition, page 4.

[6] Petition, pages 5-6.

[7] Respondents' Opposition Brief at page 4.

[8] Respondents' Opposition Brief at page 6.

gants. It will entitle the litigants to a decision by the Appeals Court based upon the proper law—a consideration important to the litigants, and to our judicial system. When the law is properly applied, it will be seen that Petitioner was, in fact, entitled to a valid patent and that Respondents have infringed that patent (the latter being an issue which the Appeals Court avoided). Respondents' assertion at page 6 of their Opposition Brief is erroneous in stating that "the patent was also ruled not to have been infringed." The Appeals Court stated "it is not necessary to pass upon the issues of infringement tried below." [9] Respondents' erroneous statement of this fact further shows that Respondents are unable to meet the question proposed, on its merits.

The ruling will also be of consequence to the bench and bar as it will define the still unanswered question of who is the man of "ordinary skill."

The *Concrete Appliances* case cited by Respondents [10] does not resolve the question. The case was decided long prior to the 1952 Act, and has been repeatedly cited as authority for the "flash of genius" test which was repudiated by the 1952 Act. Mr. Justice Douglas, in his dissent in the *Great Atlantic and Pacific Tea Co. vs. Supermarket Eq. Corp.*,[11] quotes the "inventive genius" test of Mr. Justice Stone in the aforesaid *Concrete Appliances* case. In *Cuno Engineering Corp. vs. Automatic Devices Corp.*[12] immediately after the citation of a purality of cases, including the aforesaid *Concrete Appliances* case, *cited supra*, the Court interpreted the cases by saying:

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[9] Petition, Appendix, page 31.

[10] 269 U. S. 177, 185, cited in Respondents' Opposition Brief at page 5.

[11] 340 U. S. 147, 154; 71 S. Ct. 127, 131, n. 1.

[12] 314 U. S. 84, 91; 62 S. Ct. 37, 40, 41.

> "That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling."

Moreover, even if it were proper, despite the subsequent enactment of the 1952 Act, the holding stands for the proposition that where the need is *short* (in that case it was three years) the fact that *several* other workers developed the same idea is evidence that there is not "inventive genius," where there was a progressive development. The Appellate Court decision in the *Concrete Appliances* case[13] recognized the distinction in quoting as follows from *Elliott vs. Youngstown*:[14]

> "The fact that so many persons caught the idea goes rather to prove that it was simple and obvious, and not that it required inventive genius to conceive. *It is not* like the case where the art is waiting for the device, and inventors striving unsuccessfully to produce it, under which circumstances invention may well be held to appear." (Emphasis added.)

The Supreme Court in ruling on *Concrete Appliances Co. vs. Gomery*[15] made special note of the fact that the need for a device for handling "wet" cement was not a long-felt want. This Court noted that the need did not arise until 1905, and that the assemblage of elements of the patent was made by *several* others by 1908, only *three* years later, with the intervening short period evidencing rapid development by others of portions of the ideas.

Lastly, and most important, the ruling of this Court in the *Concrete Appliances Co.* case does not answer the question propounded for review—who is the man of "ordinary skill" to whom the Patent Act refers? The Appeals Court

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[13] 291 F. 486, 491.

[14] 181 Fed. 345, 349.

[15] 269 U. S. 177, 182, 46 S. Ct. 42, 44.

in the present case held that it was Behrens, another inventor. By so doing, the "flash of genius" test was reinstated by looking to another inventor as the sole test of what is obvious to one skilled in the art. The Court of Appeals did so despite the fact that the seven systems relied upon by the Court as anticipation each failed to solve the problem, and evidenced many attempts to solve it since at least 1925.[16]

The Drafters of the Patent Act wanted to stimulate the development of ideas which were not obvious to one of ordinary skill.[17] The Drafters did not intend the test to be what is obvious to someone of *extraordinary* skill. Yet the ruling of the Appellate Court herein, by letting the fact that Behrens, himself an inventor, and holder of a German patent on the idea, be the sole basis for its opinion, has reinstated the "Inventive Genius" test which the 1952 Act replaced. It did so by erring in dealing with the other side of the coin—namely to define who is the man of "ordinary skill" to whom the statute refers. It is this question which Petitioner respectfully asks this Court to settle.

Respectfully submitted,

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[16] Petition, page 8.

[17] 35 U. S. C. Sec. 103, Printed in Petition, Appendix, at page 12.